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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,068	02/09/2001	Shichiro Miyashita	JP919990268US1	7112

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EXAMINER	
NGUYEN, NGA B	
ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/780,068	MIYASHITA, SHICHIRO	
	Examiner	Art Unit	
	Nga B. Nguyen	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *6,7 and 15-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/2/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on April 4, 2005, which paper has been placed of record in the file.

2. Claims 1-5 and 8-14 are elected for consideration.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagavath et al (hereinafter Bhagavath), U.S. Patent No. 6,505,169.

Regarding to claims 8 and 10, Bhagavath discloses a system for distributing digital content comprising:

means for collecting advertising content to be attached to music/video content including recorded digital data of music/video (column 1, lines 21-26, content media includes audio and video data; column 3, lines 28-32, the Streaming Media Cache Server 121 stores a copy of the program content package);

means for combining said music/video content with said collected advertising content to produce music/video content with advertisement so that the advertisement is

reproduced before, after, or during the performance of the music/video (column 4, lines 23-29, the AD Manager 127 inserts ads into the content); and

means for publishing on the Internet said music/video content with advertisement produced by said content combining means (column 5, lines 65-67, the HTTP Proxy 123 forwards the streaming content to the requesting customer computers 107).

Regarding to claims 9 and 11, Bhagavath further discloses wherein said collecting means comprises means for specifying at least an insertion position of said advertisement to be attached to said music/video and a length of said advertisement as conditions for attaching said advertising content to said music/video content (figure 10 and column 6, lines 43-48, the position and duration when ads may be inserted into to media stream).

5. Claims 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolfe et al (hereinafter Wolfe), U.S. Patent No. 5,931,901.

Regarding to claim 12, Wolfe discloses a method for distributing digital content through a communication network, comprising the steps of:

collecting advertising content to be attached to digital content to be distributed under the condition of payment to a provider of said digital content (column 4, lines 7-11, the database 26 stores the advertisement content; column 6, lines 13-18, the advertising messages are appended to the music; column 5, lines 33-35, calculating royalty fee payable to the owners of the music);

combining said digital content with said collected advertising content; and

publishing on said communication network said digital content to which said advertising

content is attached (column 3, lines 48-60, the music being transmitted over the Internet to the subscribers is bundled with targeted advertising material in the form of audio messages).

Regarding to claim 14, Wolfe further discloses wherein said publishing step comprises the steps of:

accepting through said communication network a request for sending said digital content (column 6, lines 20-25); and

sending said digital content to an information processing terminal issuing said request without charging (column 1, lines 50-55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhagavath et al (hereinafter Bhagavath), U.S. Patent No. 6,505,169.

Regarding to claim 1, Bhagavath discloses a network system comprising:

a content providing terminal for use by a digital content provider (figure 1 and column 3, lines 7-10, the program content supplied by the Streaming Multimedia Server 101);

an advertisement providing terminal for use by a provider of advertising content to be attached to the digital content provided by said contend providing terminal (figure 1 and column 4, lines 41-45, the Ad Server 111); and

a server connected with said content providing terminal and said advertisement providing terminal through the Internet for receiving said digital content from said content providing terminal, collecting said advertising content to be attached to the received digital content from said advertisement providing terminal (figure 1 and column 3, lines 15-27, the HTTP Proxy Server 123 connected to the Streaming Multimedia Server 101 and the Ad Server 111 through the Internet for receiving program content and advertisement content), and publishing on the Internet the digital content with advertisement produced by combining said digital content with said advertising content (column 5, lines 65-67, the HTTP Proxy 123 server forwards the streaming content to requesting customer computers 107).

Bhagavath does not disclose a server providing information to the provider of said digital content and the provider of said advertising content for making a contract between the provider of said digital content and the provider of said advertising content, said information including a condition with regard to payment to the provider of said digital content. However, such features are well known in the art of inserting an advertisement into a program content. For example, the advertisers prefer to place an advertisement into a program content in order encourage the consumers to purchase their products or services to maximize their profit (e.g. movies, television shows, web pages, etc. contain advertisements is well known in the art), in order to do so, the

advertiser must have contract agreement with the content provider to allow the advertisement inserted into the content provider's program, the advertiser usually pays the content provider a fee for the contract. Moreover, the conventional Internet provides more convenient and time consuming for the users to access the web servers to buy and sell products or services. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Bhagavath's to adopt the well known features above for the purpose of providing more convenient for the content provider and the advertiser to establish a contract over the Internet in order to maximize the profit for both content provider and advertiser.

Regarding to claim 2, Bhagavath does not disclose where said content providing terminal, said advertisement providing terminal, and said sewer communicate with each other by using a secure communication protocol. However, communicating using a secure communication protocol is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Bhagavath's to adopt the well known feature above for the purpose of improving the security in communication over the network.

Regarding to claim 3, Bhagavath discloses a network system comprising:

a content providing terminal for use by a digital content provider (figure 1 and column 3, lines 7-10, the program content supplied by the Streaming Multimedia Server 101);

an advertisement providing terminal for use by a provider of advertising content

to be attached to the digital content provided by said content providing terminal (figure 1 and column 4, lines 41-45, the Ad Server 111);

a first server connected with said content providing terminal and said advertisement providing terminal through a communication network for receiving said digital content from said content providing terminal, and collecting said advertising content to be attached to the received digital content from said advertisement providing terminal (figure 1 and column 3, lines 15-27, the HTTP Proxy Server 123 connected to the Streaming Multimedia Server 101 and the Ad Server 111 through the Internet for receiving program content and advertisement content); and

a second server for storing the digital content with advisement produced by combining said digital content received by said first server with said advertising content collected for attachment to said digital content (figure 1 and column 3, lines 29-35, the Streaming Media Cache Server 121 stores a copy of the program content package); the first server for publishing on the Internet the digital content with advisement produced by combining said digital content with said advertising content collected for attachment to said digital content (column 5, lines 65-67, the HTTP Proxy 123 server forwards the streaming content to requesting customer computers 107);

wherein the provider of said digital content and the provider of said advertising content establish a time condition in the collection of said advertising content, said time condition limiting a time period during which said digital content with said advertising content attached thereto may be published (figure 10, see "time" and "duration"), and publishes said digital content with advisement in accordance with said time condition at

the first server (column 5, lines 65-67, the HTTP Proxy 123 server forwards the streaming content to requesting customer computers 107).

Bhagavath does not disclose the provider of said digital content and the provider of said advertising content establish a time condition at said first server. However, such feature is well known in the art. For example, the conventional Internet provides more convenient and time consuming for the users to access the web servers to buy and sell products or services. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Bhagavath's to adopt the well known features above for the purpose of providing more convenient for the content provider and the advertiser to establish a contract over the Internet. Moreover, Bhagavath discloses publishes said digital content with advisement in accordance with said time condition at the first server, instead of at the second server. However, the first server and the second server are included within the Point of Presence (POP) (see figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Bhagavath's to satisfy the desired choice in the claimed invention.

Regarding to claim 4, Bhagavath does not disclose wherein the provider of said digital content and the provider of said advertising content further establish, in the collection of said advertising content at said first server, a condition with regard to payment to the provider of said digital content from the provider of said advertising content. However, such feature is well known in the art. For example, the advertisers prefer to place an advertisement into a program content in order encourage the

consumers to purchase their products or services to maximize their profit (e.g. movies, television shows, web pages, etc. contain advertisements is well known in the art), in order to do so, the advertiser must have contract agreement with the content provider to allow the advertisement inserted into the content provider's program, the advertiser usually pays the content provider a fee for the contract. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Bhagavath's to adopt the well known features above for the purpose of maximizing the profit for both the content provider and the advertiser.

Regarding to claim 5, Bhagavath further discloses wherein said first server and said second server are configured by the same hardware (figure 1, the Streaming Multimedia Server 101 and the Streaming Media Cache Server 121 both included in the Point of Service).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (hereinafter Wolfe), U.S. Patent No. 5,931,901.

Regarding to claim 13, Wolfe further discloses wherein said collecting step comprises the steps of:

specifying advisement attaching conditions for said digital content to be distributed, said conditions including at least a time condition for limiting a time period during which said digital content with the advertisement is published (column 5, lines 40-44, the total advertising air time) and a positional condition for specifying a position in said digital content where said advertisement is inserted (column 6, lines 33-40, the advertiser's message may be appended as a leader or header thereof, along with a

generic or music specific voice over, or may be appended at the end of the piece of music); and

wherein said publishing step publishes said digital content in accordance with said time condition included in said advertisement attaching conditions (column 3, lines 48-60, the music being transmitted over the Internet to the subscribers is bundled with targeted advertising material in the form of audio messages).

Wolfe does not disclose showing said digital content and said advertisement attaching conditions for said digital content to advertising content providers. However, such feature is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Wolfe's to adopt the well known feature above for the purpose of enabling the advertiser to verify the information before publishing, thus the advertiser can have the opportunity to modify or make any corrections regarding to the advertisement.

Conclusion

9. Claims 1-5 and 8-14 are rejected.

10. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Angles et al. (US 6,358,592) disclose system and method for delivering customized advertisements within interactive communication systems.

Cottingham (Us 6,339,761) discloses an Internet service provider advertising system.

Brandt et al. (US 6,701,355) disclose system and method for dynamically substituting broadcast material and targeting to specific audiences.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(703) 872-9306 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 401 Dulany Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen

June 6, 2005